

# REMARKS

Applicant has carefully considered the Examiner's Office Action and has amended the claims responsively to define the invention in clearer form and to distinguish patentably from the prior art.

Thus, applicant has replaced claims 12-4 with the newly submitted claims 5-11.

The new base claim 5 includes the subject matter and limitations that are not to be found in the prior art.

Applicant has also formulated the new claims 5-11 so as to avoid the Examiner's objections under 35 U.S.C. 112 by responding to each of the objections noted in the Office Action.

In considering the prior art, neither the British Patent GB 2 115 903 nor the U.S. reference 4,428,666 to de Baan disclose an elastically-tensioned circular ring on which a sealing lip is formed for the purpose of forming the check valve.

Accordingly, applicant's invention is not to be found in these prior art references. Applicant provides a new construction for a check valve.

It is submitted that the new base claim 5 does not read on either the British Patent GB 2 115 903 as well as the U.S. Patent to de Baan, because the novel structure of applicant's invention is not present in these references.

There is also no anticipation in these prior art references of a check valve formed on a sealing lip on a circular, elastically tensioned ring having a circular-shaped cross-section.

There is also no anticipation or hint of a flow-through diaphragm which is formed of at least one recess in a sealing seat under the circular ring.

In view thereof, it is submitted that a person working in the art cannot obtain any inspiration from these references for the purpose of arriving at applicant's invention.

In view of the preceding comparison between the prior art references and applicant's invention, it may be seen that the subject matter of applicant's arrangement as defined in the new claim 5 is novel and results from inventive thought and activity. Applicant notes, furthermore, that the new claim 5 was patented in the corresponding German application.

With respect to the Examiner's objections to the drawings, applicant notes that there is no seal outside of the dashpot as previously claimed in claim 1. Such recitation in claim 1 was in error, and the new claim avoids this error. As a result, the drawings need not be altered. It would also be meaningless to provide in applicant's invention, a seal outside of the dashpot.

Applicant has also amended the specification to provide for the required section headings, and to avoid reference to specific claim numbers.

The specification has been amended, furthermore, on page 5, line 10 to provide for the required clarification.

The Examiner's attention is respectfully directed to the court decision in the case of *In re Bisley* (94 U.S.P.Q. 80, 86), in which the Court decided that patentability is gauged not only by the extent or simplicity of physical changes, but also by the perception of the necessity or desirability of making such changes to produce a new result. When viewed after disclosure, the changes may seem simple and such as should have been obvious to those in the field. However, this does not necessarily negate invention or patentability. The conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem. Though the problem, once realized,

may be solved by use of old and known elements, this does not necessarily negate patentability.

Furthermore, in the case of ex parte Chicago Rawhide Manufacturing Company (226 U.S.P.Q. 438), the Patent Office Board of Appeals ruled that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal, is not by itself, sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the reference device to render the here-claimed device unpatentable.

In the case of United Merchants and Manufacturers Incorporated versus Ladd (139 U.S.P.Q. 199), the District Court ruled that although from simplicity of device and with advantage of hindsight, one might off-handedly be of opinion that anyone should have been able to make invention after studying prior art, claims are allowed since none of the references discloses or suggests the concept which is the crux of the invention.

Finally, in the case of Menge and Drissen (181 U.S.P.Q. 94), the Court ruled that progress in crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage; constitution envisages and seeks progress in useful "arts," not just in those more esoteric or scientific.

In view of the amendments to the claims and to the specification, and in view of the preceding remarks, it is

respectfully requested that the claims in the application be  
allowed and the case be passed to issue.

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Respectfully submitted,

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